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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John D. Dreher

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EXAMINER

YU, GINA C

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/482,773
Filing Date: January 13, 2000
Appellant(s): DREHER, JOHN D.

CYNTHIA MILLER
For Appellant

EXAMINER'S ANSWER

This is in response to the substitute appeal brief filed on February 21, 2006
appealing from the Office action mailed on January 28, 2004.

Appellants have initially filed an appeal brief on November 26, 2004 appealing from the said Office action. Reply brief was submitted on July 26, 2005 in response to the examiner's answer mailed on June 3, 2005. Subsequently, the Board of Patent appeals and Interferences found that the application is not in condition for docketing as an appeal, and required the following:

- (a) Proper consideration by the examiner of the IDS filed April 22, 2005;
- (b) Insertion into Image File Wrapper of prior art reference: Hurst, S. "Face Powders", Poucher's Perfumes, Cosmetics and Soaps, vol. 3, (1993 9th ed. by Hilda Butler), pp 116-121, Chapman & Hall; and
- (c) Submission of a substitute appeal brief in compliance with 37 CFR 41.37(c) as it was found that the brief did not contain:
 - (i) a summary of claimed subject matter as set forth in 37 CFR 41.37 (c) (1) (v);
 - (ii) grounds of rejection to be reviewed on appeal, as set forth in 37 CFR 41.37 (c)(1)(vi);
 - (iii) evidence appendix, as set forth in 37 CFR 41.37(c)(1)(ix); and
 - (iv) related proceedings appendix, as set forth in 37 CFR 41.37(c)(1)(x).

The present appeal brief was filed as a response to the notification of non-compliant appeal brief (37 C.F.R. 41.37) mailed on December 29, 2005, and contains new arguments.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,207,174 B1	HINENO ET AL.	03-2001
5,690,916	KIMURA ET AL.	11-1997

Hurst, S. "Face Powders" Poucher's Perfumes, Cosmetics and Soaps, vol. 3 (1993, 9th ed. Hilda Butler), Chapman & Hall, pp. 116-121.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Hineno et al. (US 6207174 B1) (“Hineno”).

Kimura discloses a foundation comprising 9.0 % by weight of blue interference pigment and iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other non-interference inorganic pigments which examiner views are used to match skin tone and thus meet the “skin color” limitation. See Example 13. While the claimed composition is disclosed in the prior art, the reference fails to explicitly teach using the composition to visibly reduce wrinkle or lines of the skin. Examiner views that wrinkle caused by chronic aging is a natural phenomena that obviously occurs in mature users’ skin. Thus, examiner takes the position that the prior art composition, when used by the users with aged skin, obviously renders the wrinkle minimizing effect which applicants claim.

Hineno teaches using a composite powder comprising interference or reflective pigments useful in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and the 9.32 % by weight of composite powder.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the Kimura composition as motivated by

Hineno because of the expectation of successfully enhancing wrinkle-coverage effect and improving skin color tone.

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kimura and Hineno as applied to claims 1-7 and 9-11 above, and further in view of Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993).

Kimura and Hineno, discussed above, fail to teach bismuth oxychloride.

Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2nd full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide "translucent luster, or frosted effect, to enhance the wearer's natural complexion". See p. 117, 5th full par.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding bismuth oxychloride as motivated by Hurst because of an expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

10) Response to Argument

Examiner asserts that the Office has made a prima facie obviousness case in rejecting claims 1-7 and 9-11 over Kimura ('916) and Hineno ('174) as above; and in rejecting claim 2 over Kimura and Hineno and further in view of Hurst. The primary issue in this case is whether, given the collective teachings of Kimura ('916) and Hineno ('174), the claimed method of reducing wrinkles and lines of skin by topically

applying the cosmetic composition of Kimura ('916) would have been obvious to one of ordinary skill in the art.

A. The claimed invention is prima facie obvious in view of the combined teachings of Kimura and Hineno.

Appellants highlight the deficiencies of each of the references to argue that no prima facie case of obviousness has been established by the present rejection. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The cosmetic composition comprising blue interference pigments, which is used in the presently claimed method, already has been known and practiced in the art, according to Kimura ('916). Hineno ('174) teaches that it is also well known in the art that interference pigments in cosmetic composition covers wrinkle on the skin.

Appellants assert that the skilled artisan who read Hineno ('174) would have believed that only red interference pigment would be effective in wrinkle coverage because the cosmetic examples in the reference happened to use the red pigment. Examiner asserts that the argument is unpersuasive because (a) it is well known in patent law that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments, see In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); (b) nowhere in the reference

teaches that the wrinkle covering effect is attributed to the red color of the interference pigments; (c) the reference teaches other interference pigments including reddish purple or blue.

It is well settled in patent law that “the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” See MPEP § 2123, quoting In re Heck, 699 F. 2d 1331, 216 U.S.P.Q. 1038 (Fed. Cir. 1983). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 U.S.P.Q. 2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). In the present case there is no teaching or suggestion in Hineno, either expressly or implicitly, that only red interference color would exhibit the wrinkle camouflaging effects. It is also respectfully noted that in Examples 1 and 2 of Hineno, the red pigments are formed from purplish red pigments, which is similar to “violet” color, and that the reference also teaches the use of blue interference pigments, although no specific example of cosmetic formulation with blue pigment is shown. Examiner asserts that the use of blue interference pigments in cosmetic compositions to practice the Hineno method of covering wrinkle coverage is a nonpreferred embodiment and not a nonobvious which would have been obvious to the skilled artisan.

Appellants assert, “the examiner has merely relied on personal opinion and has provided no extrinsic evidence as proof that one skilled in the art would expect

that applying the '916 reference (Kimura) composition to discolored skin would necessarily result in its application to age-wrinkled skin". Examiner respectfully disagrees, as the court in In re Preda held, "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." See 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In this case, examiner relied on the objective teaching of the Hineno ('174) reference to show that it is well known in cosmetic art that interference pigments have wrinkle covering effects when applied to skin. Both Kimura and Hineno references use the light scattering effects of the interference pigments to alter the visual perception of the painted substrates by the viewers. Appellants' cosmetic composition comprising blue interference pigments already has been described in Kimura. It should be also noted that one of ordinary skill in the art would have been motivated to use the Kimura composition for the cosmetic benefits other than coverage of hyperpigmentation. Kimura teaches the visual effects of using both red and blue interference pigments in cosmetics for their color camouflaging effects and transparent feel and natural finish. This indicates that one of ordinary skill in the art would have been motivated to use the Kimura invention not only for hyperpigmentation, but also for other cosmetic benefits that these interference pigments commonly offer, as appellants have done in this case. Thus, further in view of the teaching in Hineno that cosmetic composition comprising purplish-red/red interference pigments render wrinkle coverage effects, a skilled artisan would have

reasonably expected that the topical application of Kimura composition would also camouflage wrinkles of the skin due to the light scattering properties of the blue interference pigments.

Appellants also comment that the Kimura patent and the present invention are not directed to the same population. Appellants assert that one of ordinary skill in the art will “immediately understand” the Kimura composition is not directed to reduce the appearance of lines and wrinkles associated with aging of the skin. Examiner respectfully disagrees. It is not even clear how to distinguish the appearance of lines and wrinkles from aging, from naturally forming lines and wrinkles, which all populations have, or from the lines and wrinkles that formed by exposure to other factors such as smoking, UV rays, weather, skin disease, or pollution, etc. The present case should be distinguished from the facts of Nicholas V. Perricone, M.D. v. Medicis Pharmaceutical Corporation in that the claims in that case involved a treatment method of a clearly distinctive skin condition, unlike in the present case. See No. 05-1022, December 20, 2005, CAFC. The “age-winkled skin”, unlike sunburn skin, applies to all population and there is no measure or standard to classify the specific population with such condition.

Appellants also argue that Kimura teaches against using a high amount of interference pigments. Examiner respectfully notes that the claimed invention is not limited to using any specified amount of the pigments.

B. The present rejection is not based upon improper hindsight and should be sustained.

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellants' disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, based on the objective teachings found in these references,

the skilled artisan would have reasonably concluded that the Kimura method of topically applying a composition comprising blue interference pigments would produce wrinkle covering effects, as appellants have done.

C. Claim rejection of claim 8 made in view of Kimura ('916) and Hineno ('714) and further in view of Hurst is proper.

Appellants argue that the rejection of claim 8 is improper, again by pointing out how individual reference fails to teach the claimed invention. The argument is unpersuasive because the rejection is made in view of what the combined teachings of the references would have taught, suggested, and motivated one of ordinary skill in the art. As stated in the rejection, the collective teachings of the references support the conclusion that the skilled artisan would have been motivated to add bismuth oxychloride to the Kimura cosmetic composition to enhance the natural look upon the skin.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

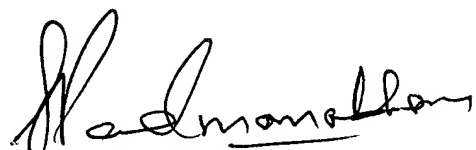
Respectfully submitted,

Gina Yu



SHENGJUNWANG
PRIMARY EXAMINER

Conferees:



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